

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claim 8 has been canceled and the substance of claim 8 taken into claim 1.

Applicants reserve the right to prosecute the original broader subject matter in a divisional application.

Claim 4 was objected to as reciting a fraction of 0-35% by weight for component b), which the Examiner found to be inconsistent with component a) which allowed for a lower limit of 70% by weight of component a). In response, Applicants have amended component b) to recite an upper limit of 30%. The upper limit is supported by the original language of 0-35% by weight.

Claims 9 and 15 were rejected under 35 USC § 112, second paragraph, as being indefinite in their use of the phrase "substantially identical." In response, Applicants have amended these claims to provide for identity. Differences in the polyacrylate composition remain covered by the broader claims.

Claims 1, 2, 4, 5, 10-17, 19 and 20 were rejected under 35 USC § 102(b) as being anticipated by Schmidt et al. ("Schmidt"), US 5,910,522. In response, Applicants point out that claim 8 was not subject to this rejection. As noted above, the substance of claim 8 has been taken into claim 1. Besides claim 1, the other rejected claims depend directly or indirectly from claim 1 and, therefore, also incorporate the substance of claim 8. In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Claim 3 was rejected under 35 USC § 102(b) as being anticipated by Schmidt as evidenced by Knovel. In response, Applicants point out that claim 8 was not subject to

this rejection. As noted above, the substance of claim 8 has been taken into claim 1. Claim 3 depends from claim 1 and, therefore, also incorporates the substance of claim 8. In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well.

Claims 1, 2, 4-6, 10-17, 19 and 20 were rejected under 35 USC § 103(a) as being obvious over Husemann et al. ("Husemann"), US 6,958,186, taken in view of Schmidt. In response, Applicants point out that claim 8 was not subject to this rejection. As noted above, the substance of claim 8 has been taken into claim 1. Besides claim 1, the other rejected claims depend directly or indirectly from claim 1 and, therefore, also incorporate the substance of claim 8. In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection

Finally, claims 7-9 were rejected under 35 USC § 103 as being obvious over Schmidt. In response, Applicants point out that claim 8 has been canceled, and claims 7 and 9, as noted above, incorporate the substance of claim 8. Thus, these claims require "polyacrylate-coated particles of silicate and/or of silica gel." According to the Examiner, Schmidt's particles are "in contact with the initiator and polymerizable monomer, which would lead to the silicate particles being functionalized with initiator and polymerizable monomer by adsorption." However, there is no support for this in the record.

As pointed out by the Board of Patent Appeals and Interferences in *Ex parte Levy*, 17 USPQ2d 1461, 1463-1464 (BPAI 1990):

"[T]he initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests upon the Examiner. * * * In relying upon the theory of inherency,

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Amendment under 37 CFR § 1.111 filed May 29, 2007

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the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. [Emphasis in original]"

Applicants submit that the Examiner has not discharged this initial burden. The Examiner has not shown that it is *necessarily* the case that silicate and/or silica gel particles could be functionalized merely by contacting the particles with an initiator. Absent such a showing, the Examiner has not proven inherency, and, thus, has not made out a *prima facie* case of obviousness.

Even if a *prima facie* case of obviousness could be said to be made out — a point which Applicants do not concede — the present invention is characterized by unexpected results demonstrated in the instant specification on pages 12-13. Instant Example 9 employs initiator-functionalized silica gel particles. As proven by the data, which is discussed at page 13, lines 8 ff, this functionalization has a beneficial effect on slittability. Experiments with the inventive adhesive show that it exhibits reduced adhesion to the knife and during the course of slitting, the number of picks is reduced, so that the optical quality of the resulting PSA tape is significantly increased.

There is no teaching or suggestion in Schmidt that use of initiator-functionalized particles should bring about the demonstrated increase in this important property. Accordingly, the data in the instant specification must be considered to be surprising and, therefore, unexpected, and, thus, also as objective evidence of nonobviousness. Although these data are not in declaration form, consistent with the rule that *all* evidence of nonobviousness must be considered when assessing patentability, the Examiner must consider data in the specification in determining

whether the claimed invention provides unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

In view of the foregoing, Applicants respectfully submit that the Examiner would be fully justified to reconsider and withdraw this rejection as well. An early notice that this rejection has also been reconsidered and withdrawn is also earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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